

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Bruce L. Kennedy
Application No. 10/662,599	Filing Date: September 15, 2003
Title of Application:	Video Recording and Image Capture Device
Confirmation No. 2356	Art Unit: 3739
Examiner	Philip R. Smith

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appeal Brief Under 37 CFR §41.37

Dear Sir:

A Notice of Appeal from the final rejection of Claims 19-22, 24-31, 46 and 48-49, all pending claims of U.S. Patent Application No. 10/662,599, having been filed on April 12, 2011, Applicant accordingly files its Substitute Appeal Brief in connection with its appeal. A Claims Appendix is submitted herewith, as are Appendices related to evidence previously submitted and decisions related to the case.

(i) Real Party In Interest

The real party in interest is Karl Storz Imaging, Inc., of Goleta, CA, USA assignee of the present patent application.

(ii) Related Appeals and Interferences

The present application was previously appealed to the Board of Patent Appeals and Interferences. U.S. Patent Application Serial No. 11/229,152, filed on September 16, 2005, which is a divisional application claiming priority to the present application, is currently on appeal.

There are no other related appeals, interferences or judicial proceedings known to Appellant, the Appellant's legal representative, or Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii) Status Of Claims

Claims 1-18 and 32-45 have been withdrawn from prosecution. Claims 19-22, 24-31, 46 and 48-49, all of the pending claims of the present application stand rejected and are the subject of the instant Appeal. Claims 23 and 47 have been cancelled. A copy of each of these claims is attached hereto in the Claims Appendix.

(iv) Status Of Amendments

There are no pending or unentered Amendments to the claims. Appellant appeals from the Final Official Action mailed February 18, 2011.

(v) Summary Of Claimed Subject Matter

Claim 19 the sole independent claim pending in the case.

Independent Claim 19

Claim 19 is directed toward medical video instrument having touch screen control (p. 1, ll. 7-10; p. 5, ll. 15-17; p. 7, ll. 1-7; p. 13, ll. 3-12; p. 15, l. 14 – p. 16, l. 16; FIGS. 2, 4, 5a-5c, 14a-14b & 15). The instrument further includes a touch screen for entering control commands to control the medical video instrument. (p. 7, ll. 1-7; p. 10, ll. 1-9; p. 14, ll. 1-12; p. 15, l. 14 – p. 18, l. 10; p. 23, l. 5 – p. 24, l. 5; p. p. 26, ll. 6-10; FIGS. 2, 4, 5a-5c, 14a-14b & 15), where the medical video instrument is inserted into a body cavity and generates an image stream representative of the body cavity and displayed on the touch screen (p. 5, ll. 1-4; p. 11, l. 1 – p. 13, l. 2; p. 15, ll. 5-8; p. 24, l. 5 – p. 25, l. 7; p. 29, ll. 7-10; FIG. 1). The instrument still further includes a processor for receiving the control commands and for generating control signals to operate the medical video instrument (p. 7, ll. 1-7; p. 13, ll. 3-12; p. 14, ll. 1-12; p. 30, l. 7 – p. 31, l. 12; FIG. 4). The instrument also includes a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing (p. 7, ll. 1-7; p. 16, l. 17 – p. 17, l. 3; FIGS. 5a-5c & 15), said touch screen deflectable about an axis of said housing (p. 7, ll. 5-7; p. 10, ll. 7-9; p. 16, ll. 13-15; p. 33, ll. 13-14; p. 35, ll. 5-6; p. 36, ll. 12-13; FIGS. 5a – 5c & 15).

(vi) Grounds Of Rejection To Be Reviewed On Appeal

(a) Claims 24 and 25 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

(b) Claims 19-22, 26-31, 46 and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0076410 (“Beutter”) in view of U.S. Published Patent Application No. 2002/0149706 (“Rosen”).

(c) Claim 48 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter in view of Rosen and further in view of U.S. Published Patent Application No. 2003/0060678 (“Watai”).

(vii) Argument

(a) Rejections under 35 U.S.C. §112, First Paragraph

Claim 24 recites, “The medical instrument of claim 19 in which said touch screen is easier to deflect in one direction than in the other direction.” Claim 25 recites, “The medical instrument of claim 25 in which said touch screen is more difficult to deflect in the opening direction than in the closing direction.”

(1) Claims 24 and 25

The Examiner has rejected claims 24 and 25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement stating,

said touch screen is easier to deflect in one direction (opening) than in the other direction (closing). According to the specification, the touch screen is attached by a “hinge 142” that is equipped with “one or more tapping mechanisms”. Conventional hinges are equally easy to deflect in either direction. The specified “hinge 142” appears to be a conventional hinge. The only unconventional feature is a “tapping mechanism.” It is not entirely clear what a tapping mechanism is, but there is no suggestion that it makes the “hinge 142” more deflectable in one direction than in another.

Official Action 2/18/11, p. 2. The examiner further submits “that a skilled endoscopist could not produce a hinge that independently offers more resistance in one direction than another. A conventional hinge, the definition of which might be found in the dictionary, offers the same amount of resistance when rotating in one direction as it does the opposite direction. If a hinged structure is more difficult to rotate in one direction rather than another, this must be the result of an independent biasing element, such as a spring. Official Action, 2/18/11, p. 6 Finally, the examiner submits that “[m]oreover, there is a substantial difference between (A) greater resistance to movement in one direction relative to the opposite direction, as recited in the claim, and (B) resistance to unintentional movement, as taught in the specification. The latter merely implies that frictional resistance in *both* directions is substantial, there is no implied difference in resistance depending on the direction of rotation.” *Id.*

As an initial matter, Appellant objects to the examiner’s rejection of claims 24 and 25 at this late date during prosecution. These rejections could have been made in any of the previous Official Actions prior to the first Appeal to the Board of Patent Appeals and Interferences (BPAI). For example, claims 24 and 25 were filed with the original claim set. The first Official Action issued 6/9/05 included these claims, but no rejection was made for these claims under 35 U.S.C. §112. Likewise, a second Official Action was mailed on October 13, 2005 that included these originally filed claims 24 and 25, but the examiner did not provide any rejection under 35 U.S.C. §112. Third, fourth and fifth Official Actions mailed March 17, 2006, July 7, 2006 and August 17, 2006 respectively, likewise did not include any rejection of these claims under 35 U.S.C. §112. Appellant finally appealed the case and the Decision on Appeal was mailed May 25, 2010 in which these claims were pending and no issue was found with respect to deficiencies under 35 U.S.C. §112. It wasn’t until the sixth Official Action mailed on September 20, 2010 that the examiner inappropriately first rejected these originally filed claims under

35 U.S.C. §112.¹ MPEP 707.07(g) (“Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.”) In this case, the examiner waited until the sixth Official Action and after an appeal to raise this issue with the originally filed claims.

With regard to the merits of the examiner’s 112 rejection, it should first be noted that there is a strong presumption that an adequate written description is present when the application is filed. MPEP 2163 (There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”). Claims 24 and 25 were originally filed in the application and have been pending and under examination from the beginning. The examiner has provided no evidence to overcome this “strong presumption.”

The enablement requirement of 35 U.S.C. §112 is concerned with whether the specification adequately describes how to make and use the invention. The analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims so as to enable one skilled in the pertinent art to make and use the claimed invention. See MPEP § 2164.01. The enablement requirement applies to those skilled in the art, not to an average person reading the patent.

¹ Appellant notes that the examiner also made inappropriate comments in the Official Action of 9/20/10 criticizing the BPAI’s decision by providing partial quotations with examiner supplied emphasis on certain portions thereof, which, in Appellant’s opinion, was an inappropriate attempt to change and/or narrow the meaning of the BPAI’s decision especially in view of the examiner’s accompanying comments. Official Action September 20, 2010, p. 2 at [01].

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1556, 220 U.S.P.Q. 303, 315 (Fed. Cir. 1983) (“Patents, however, are written to enable those skilled in the art to practice the invention, not the public.”). Therefore, in order for a patent to suffer from lack of enablement, it must really be the case that a person who is actually skilled in the relevant art could truly not practice the claimed invention without conducting undue experimentation.

Starting from the perspective of those skilled in the art, a lack of enablement occurs when the disclosure leaves such skilled persons in a position where they still must perform extensive experimentation in order to practice the invention—in other words, they are required to engage, not merely in “some” experimentation, but in “undue” experimentation. *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) (“Enablement is not precluded by the necessity for some experimentation... the key word is ‘undue,’ not ‘experimentation.’”); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986) (enablement “is not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly extensive.”).

Therefore, because “[t]he question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention... the specification need not disclose what is well known in the art.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”) In other words, the specification need not lay out every step necessary to practice the invention, but rather, must point those skilled in the art in the right direction so that they can, using the existing knowledge in the art, practice the invention. *In re Wands*, 858 F.2d at 737 (“The determination of

what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art... The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.”). Therefore, “[a] patent need not teach, and preferably omits, what is well known in the art.” *Hybritech*, 802 F.2d at 1384. Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576 (Fed. Cir. 1984).

The examiner has provided a number of statements to support the rejection under section 112, however, no analysis was provided as to how or why the examiner made these “underlying factual findings.” For example, the examiner has made the following statements:

1. “A conventional hinge, the definition of which might be found in the dictionary, offers the same amount of resistance when rotating in one direction as it does the opposite direction.”
2. “The specified “hinge 142” appears to be a conventional hinge.
3. “a skilled endoscopist could not produce a hinge that independently offers more resistance in one direction than another”

Official Action 2/18/11 pp. 2 & 5. As to the first statement, the examiner has not provided any evidence that this statement is true. First, what type of hinge is the examiner referring to? A hinge on a door of a house? A car door hinge? A hinge on a laptop computer? Each of those above described hinges exhibit different characteristics. For example, a hinge on a house door does freely move in two directions, but a car door hinge does not as it is typically biased to maintain the door in

position at various deflection points. The hinge on a laptop computer will maintain the screen at whatever position the screen is deflected to exhibiting resistance to any change of position. However, the examiner's blanket statement provides absolutely no direction as to what a "conventional hinge" he refers to is. As to the second statement, the examiner provides no evidence to support this statement. On the contrary, the application refutes the examiner's conclusion stating "To prevent changing angle of the platform 144 or accidental closure, one or more tapping mechanisms are disposed with hinge 142, that make it resistant to unintentional movement." ¶59; see also "Platform 144 may be of any suitable design to hold touchscreen 145 even when placed at an angle from horizontal" ¶57. As to the third statement, there is absolutely no evidence of record to support this bald conclusion. With regard to the examiner's third statement, the MPEP states,

While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written enablement rejection. The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact.

MPEP 2164.04 (emphasis in original). The examiner has not provided any analysis of the factors discussed in MPEP § 2164.01(a) nor has the examiner made "specific findings of fact, supported by the evidence." *Id.* On this basis alone, the rejection under 35 U.S.C. §112 should be overturned.

Finally, the examiner has submitted that "[m]oreover, there is a substantial difference between (A) greater resistance to movement in one direction relative to the opposite direction, as recited in the claim, and (B) resistance to unintentional movement, as taught in the specification. The latter merely implies that frictional resistance in *both* di-

rections is substantial, there is no implied difference in resistance depending on the direction of rotation.” Official Action 2/18/11 p. 6. It appears that the examiner is arguing that the original filed application did not disclose or teach that the touch screen would be more difficult to deflect in the opening direction than the closing direction. However, the originally filed application stated as follows:

- 1) The “touch screen is easier to deflect in one direction than in the other direction.”
- 2) The “touch screen is more difficult to deflect in the opening direction than in the closing direction to permit said touch screen to be tapped without unintentionally deflecting said touch screen.”

Originally filed specification, p. 35, ll. 7-12. Accordingly, the originally filed specification disclosed that the “platform 144” is provided with a mechanism to “make it resistant to unintentional movement” and that the “touch screen is more difficult to deflect in the opening direction than in the closing direction.” Originally filed specification, ¶¶57 & 59; p. 35, ll. 7-12.

Here, Applicants have disclosed a novel and nonobvious system² that, in one embodiment, includes a touch screen that is deflectable about an axis that presents greater resistant to opening than to closing. Accordingly, Appellant respectfully requests the examiner’s rejection of claims 24-25 under 35 U.S.C. §112 be reversed.

(b) Rejections under 35 U.S.C. §103(a)

² While the examiner has submitted, “Applicant relies on the precept that “a patent need not teach, and preferably omits, what is well known in the art.” In the very next sentence, Applicant asserts that they “have disclosed a novel and nonobvious touch screen that presents greater resistance to opening than to closing.” A hinge can not be both “well known in the art” as well as “novel and nonobvious.” Official Action 2/14/11, p. 5. Appellant again respectfully submits that the combination of elements in claim 19 in addition to the elements of claim 24 and/or 25 is novel and nonobvious. That the examiner is seeking to take Appellant’s words out of context is disingenuous.

The Examiner has rejected claims 19-22, 26-31, 46 and 49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0076410 (Beutter) in view of U.S. Patent Application Publication No. 2002/0149706 (Rosen). The Examiner has also rejected claim 48 under 35 U.S.C. 103(a) as being unpatentable over Beutter in view of Rosen and Watai.

(1) Claim 19

Claim 19 recites “A medical video instrument having touch screen control comprising . . . a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing.”

The examiner has submitted that “Beutter does not disclose . . . said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing” but that “Rosen discloses . . . that a touch screen (“20”) is movable between a first position at least partially within a footprint (“slot 18”) of a housing and a second position (see Figures 5-6) extended from said footprint (“free space adjacent to free edge 16”) of said housing, said screen deflectable about an axis (“x” in Figure 6; [0028]) of said housing. See [0025]-[0028].” Official Action 2/18/11, p. 3 (emphasis in original). The examiner then concludes “it would have been obvious . . . to combine the medical video instrument disclosed by Beutter with the retractable monitor disclosed by Rosen. It is obvious to combine prior art elements according to known methods to yield predictable results. In combination, the medical video instrument and the retractable monitor would have performed the same function as they had separately; a skill artisan would have recognized that the result of the combination was predictable.” Official Action 2/18/11, pp. 3-4.

Rosen is not a medical video instrument nor does it teach or suggest any type of interaction with the “display screen” taught therein. Rather, Rosen teaches a “display screen” where the “screen may be of any type, but preferably will take the form of a flat panel display screen, such as a liquid crystal display (LCD) screen or a thin film transistor (TFT) display screen.” ¶¶ 15 & 19. Rosen further teaches “a video display configured for storage within an edge of a table or counter, particularly in locations where space is limited. For example, such a video display would be useful in recreational vehicles, campers, buses and boats, where space is at a premium, but where video displays are often used.” ¶2. The “display screen 20” was provided to take the place of a “traditional CRT” display, which is provided to display television/video programs to a user. ¶¶ 3 & 4. Accordingly, the system taught in Rosen is a device having a frame with guide rails positioned therein for allowing a display screen to be extended from a countertop in an RV such that a television screen where the device can be installed in or under the countertop. See e.g. FIGS. 1-7.

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976).

Appellant disagrees with the examiner’s statement that “the medical video instrument and the retractable monitor would have performed the same function as they had separately.” Official Action 2/18/11, pp. 3-4. Rosen teaches that a “display screen

20” may be positioned in a “frame 26” that may then be affixed to the underneath of a “tabletop, a countertop, a work bench top, a desktop or any article of furniture that incorporates a generally horizontal top with a thickness suitable to house a video display”, such as found “in recreational vehicles, campers, buses and boats.” ¶¶ 2, 15, 16; FIGS. 1-7. Accordingly, Rosen teaches that the device is provided to affix a display screen to an interior of a countertop thereby saving the limited countertop space. There is no teaching in Rosen that it would be advantageous to position the video display in a camera control unit, in fact, Rosen actually teaches against this suggestion in that it teaches the device should be installed in fixed surface, such as, a countertop or desktop. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984) (It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.) The examiner has submitted,

“[w]hile it may have been Rosen’s inspiration [use in a recreational vehicle], he clearly recommends it for any location “where space is limited” ([0002]). Rosen states explicitly at [0016] that

Utility structure 12 can be a utility structure of any useful size, or may take form of a tabletop, a countertop, a work bench top, a desktop, **or any article of furniture that incorporate a generally horizontal tope with a thickness suitable to house a video display such as that described herein.**

Official Action 2/18/11, p. 7 (emphasis provided by examiner). At best, Rosen teaches that the device can be installed in any type of furniture with a flat top of a thickness to accommodate the device to be situated therein. This provides absolutely no motivation, however, to install the device in a medical instrument (e.g. a camera control unit). The “medical video instrument” of claim 19 is not installed in any article of furniture whatsoever. The examiner, however, simply ignores this primary teaching of Rosen by stating that “a hospital room is certainly a place where ‘space is limited’, and a skilled artisan would be motivated to provide the touch screen of Beutter in stowable, space-saving arrangement such as the arrangement taught in Beutter.” Official Action 2/18/11,

p. 7. However, “it is error to reconstruct the claimed invention from the prior art by using the patentee’s claim as a blueprint. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination.” *Interconnect Planning Corporation v. Feil*, 227 USPQ 543 (Fed. Cir. 1985). In this case, the examiner is arguing that it would be obvious to ignore a primary teaching of Rosen (e.g. the device is installed in an article of furniture), and that a skilled artisan would know to only take the specific portion of Rosen teaching the track arrangement for combination with a medical instrument.

Likewise, there is no teaching in Beutter that it would be advantageous to combine the separate “camera control unit 34” and separate “monitor 36” into single device. ¶¶ 27, 28; FIG. 1. Even if one were to combine the teachings of Beutter with Rosen, one would end up with a combination camera control unit with a monitor integral there to installed into a piece of furniture in which the screen may be extracted and flipped up. However, it is unclear if the “camera control unit 34” could be installed into a piece of furniture as the camera control unit is substantially larger than the housing taught in Rosen.

Accordingly, Appellant respectfully requests that the rejection of claim 19 under 35 U.S.C. 103(a) be reversed.

(2) Claim 20

Claim 20 recites the “medical instrument of claim 19 in which said touch screen is unpluggable from said housing.”

Appellant further respectfully submits that in the rack mounted system configuration, the device and the touch screen is unpluggable from the housing as per claim 20 and illustrated in Figure 14a. Neither Beutter nor Rosen teach or disclose this limitation

nor has the Examiner provided any motivation as to why it would be obvious to further modify the prior art to provide such a configuration as none of the references are provided for a rack mounted arrangement. In fact, Rosen teaches away from such a configuration as Rosen teaches that the device is installed in an article of furniture. There is no teaching in Rosen that the display or the device holding the display is “unpluggable” from other equipment or from the article of furniture that it is installed in. Likewise, there is no teaching in Beutter that the touch screen is “stackable” with other equipment or “unpluggable” as recited in claim 20.

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, the Examiner has not identified all the elements of claim 20 (“said touch screen is unpluggable from said housing”), nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

Accordingly, Applicant respectfully submits that Claim 20 cannot be obvious over Beutter in view of Rosen.

(3) Claim 21

Claim 21 recites the “medical instrument of claim 19 in which said housing and said touch screen include stackable mating plug portions.”

The presently claimed invention is intended for use in an operating room environment, for example, the specification teaches use of a “network” and “interfacing with the Karl Storz®, Inc. Storz Communication Bus (SCB).” ¶49. The “bus” that the device is capable of being coupled with is described as a “vertically stacked IDE bus 116.” ¶¶48 & 70; “the bus being vertically stacked and connected to the main board”, Ab-

stract. The medical video instrument as described herein, is a device that may be vertically stacked in a rack. ¶11. However, Rosen teaches that the device is provided to be installed in an article of furniture. If the device of Beutter was combined with Rosen and provided with “stackable mating plug portions” for stacking onto other pieces of equipment, the device would not fit in the countertop surface.

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, the Examiner has not identified all the elements of claim 20 (“stackable mating plug portions”), nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. In fact, Rosen teaches away from this configuration and as such, it cannot be obvious to modify Beutter with Rosen and further to include “stackable mating plug portions” according to claim 21. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984)

Accordingly, Applicant respectfully submits that Claim 21 cannot be obvious over Beutter in view of Rosen.

(4) Claim 22

Claim 22 recites the “medical instrument of claim 20 in which said touch screen can be used by a plurality of medical instruments.”

Appellant still further submits that claim 22 further recites “said touch screen can be used by a plurality of medical instruments.” The Examiner has simply stated “said touch screen can be used by a plurality of medical instruments” but provides no evidence to support this statement. (Official Action 2/18/11, p. 4; Official Action 9/20/11, p. 5) Appellant respectfully submits that it is incumbent upon the Examiner to establish the

factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). While the Examiner has not specifically stated that Official Notice is taken with regard to the limitation of claim 22, it appears the Examiner is alluding to this as there is no teaching in either reference nor has the Examiner cited to any location in the prior art to support this conclusion.

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, the Examiner has not identified all the elements of claim 20 in any of the cited references (“said touch screen can be used by a plurality of medical instruments”), nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

With respect to the appropriateness of taking Official Notice in general, the MPEP and case law makes clear that the situations when taking Official Notice is appropriate are extremely limited. More specifically, MPEP 2144.03, in part, states the following:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

The MPEP and case law also make clear the fact that if Applicant challenges a factual assertion as not properly officially noticed, the Examiner must support the finding with adequate evidence. In this regard, MPEP 2144.03, in part, states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the

rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

In the present case the Examiner has simply stated that that "said touch screen can be used by a plurality of medical instruments." (Official Action 2/18/11, p. 4; *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.") Accordingly, the rejection of claim 22 is also improper.

Accordingly, Applicant respectfully submits that Claim 22 cannot be obvious over Beutter in view of Rosen.

(5) Claims 24-31, 46 and 48-49

As claims 24-31, 46 and 48-49 all ultimately depend from claim 19, each of claims 24-31, 46 and 48-49 includes all the limitations of claim 19 and are therefore patentable for the reasons stated above in connection with claim 19

Accordingly, Applicant respectfully submits that Claims 24-31, 46 and 48-49 cannot be obvious over Beutter in view of Rosen.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of claims 19-22, 24-31, 46 and 48-49 is patentable over the cited prior art. As such, Applicant respectfully requests that the rejections of each of claims

19-22, 24-31, 46 and 48-49 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of claims 19-22, 24-31, 46 and 48-49.

Respectfully submitted,

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/Wesley W. Whitmyer, Jr./
Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

(viii) Claims Appendix to Appeal Brief Under 37 CFR §41.37

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1. A device for medical video recording comprising:
an endoscope;
a digital media; and
an imager in communication with said endoscope, said imager converting energy received from said endoscope to signals that are contemporaneously stored onto said digital media.
2. The device of claim 1 further comprising an encoder in communication with said imager, said encoder compressing said signals.
3. The device of claim 1 wherein said media is an optical disc.
4. The device of claim 3 wherein said media is a digital versatile disk.
5. The device of claim 4 wherein said stored signals are stored as VOB files.
6. The device of claim 2 wherein said encoder is an MPEG encoder.
7. The device of claim 1 wherein said imager is a solid state device.
8. The device of claim 1 wherein said imager includes a still frame grabber.
9. The device of claim 8 wherein said imager stores still frames on said media.

10. The device of claim 1 further including a touch screen for entering control commands for said imager and said endoscope and said touchscreen is responsive to a touch by a user.

11. The device of claim 10 further including a housing, said housing enclosing said imager.

12. The device of claim 11 wherein said touch screen is at least partially retractable within a footprint of said housing.

13. The device of claim 11 wherein the touch screen is slidable at least partially out of a footprint of said housing.

14. The device of claim 11 wherein the touch screen is deflectable relative to said housing.

15. The device of claim 11 wherein the touch screen is pivotable relative to said housing.

16. The device of claim 10 wherein said touch screen displays said signal.

17. The device of claim 1 wherein said signal is electromagnetic energy.

18. The device of claim 1 wherein said signal is direct current energy.

19. A medical video instrument having touch screen control comprising:
a touch screen for entering control commands to control said medical video instrument;

said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen;

a processor for receiving said control commands and for generating control signals to operate said medical video instrument; and

a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing.

20. The medical instrument of claim 19 in which said touch screen is unpluggable from said housing.

21. The medical instrument of claim 19 in which said housing and said touch screen include stackable mating plug portions.

22. The medical instrument of claim 20 in which said touch screen can be used by a plurality of medical instruments.

23. (cancelled)

24. The medical instrument of claim 19 in which said touch screen is easier to deflect in one direction than in the other direction.

25. The medical instrument of claim 19 in which said touch screen is more difficult to deflect in the opening direction than in the closing direction.

26. The medical instrument of claim 19 in which said touch screen presents a keyboard to a user.

27. The medical instrument of claim 19 further comprising a sensor in communication with said processor, said sensor receiving control signals to operate said medical instrument.

28. The medical instrument of claim 19 further comprising a speech recognition module executing on said processor, said speech recognition module receiving voice signals that control said medical instrument.

29. The medical instrument of claim 19 further comprising a expert system executing on said processor, said expert system generating control signals to operate said medical instrument.

30. The medical instrument of claim 19 in which said touch screen slides out of said housing.

31. The medical instrument of claim 19 in which said touch screen slides out of said housing and is deflectable.

32. A video recording and image capture device for recording data comprising:
a main board;
a first and second bus in communication with said main board;
an interface operable to receive a signal and forward the signal to said first bus;
an imager in communication with said main board, said imager recording said signal while contemporaneously writing said signal, said imager operably connected to said second bus; and
a touch screen connected to said second bus and responsive to a touch by a user, said touch screen for entering control commands for said interface.

33. The device of claim 32 wherein said interface is operable to receive and process said signal into an MPEG stream, said interface connected on said first bus to the main board.

34. The device of claim 32 and 33 wherein said imager records and writes said files as an MPEG stream.

35. The device of claim 32 further comprising a database module executing on said main board, said database module structuring storage of said files.

36. The device of claim 32 further comprising a sensor in communication with said main board, said sensor generating control signals to operate said device.

37. The device of claim 32 further comprising a speech recognition module executing on said main board, said speech recognition module generating control signals to operate the device.

38. The device of claim 32 further comprising an expert system executing on said main board, said expert system generating control signals to operate said device.

39. The device of claim 32 further comprising a stereoscopic module executing on said main board, said stereoscopic module associating a plurality of files to provide stereoscopic images on said interface.

40. The device of claim 32 wherein said interface comprises at least one relay to route an input signal to a corresponding output connector for providing an output signal regardless of the operation status of said device.

41. An interface for processing a signal for recording video into a multiple frame layer comprising:

- a controller for an inter-ic bus for providing a multiple master digital connection;
- an analog to digital converter for converting a video signal to a first digital stream, said converter operably connected to said inter-ic bus;

- a video compression and decompression integrated circuit for encoding said first digital stream into a second digital stream having frames, and decoding said second digital stream, said video compression and decompression integrated circuit operably connected to said inter-ic bus; and

- a programmable buffer for selectively saving frames handled by said controller, said buffer operably connected to said controller and said video compression and decompression integrated circuit, and said buffer inserting said frames into said second digital stream for decoding.

42. A method for recording an MPEG file for documenting surgical procedures while displaying an MPEG stream and a plurality of selected still image files corresponding to the MPEG stream, comprising the steps of:

- providing a first digital data stream comprising a video signal,
- providing a second digital data stream comprising an audio signal,
- multiplexing an MPEG data stream from said first and second digital data stream,
- streaming said MPEG data stream to an imager operably connected on a bus;
- writing said MPEG stream to said imager;
- displaying said MPEG stream on a display unit;
- selecting a number of frames from said MPEG stream;
- converting the frames to still image files; and
- multiplexing a signal to said display unit by adding the still image files.

43. The method of claim 42 in which said still image files are in JPEG format.

- 44. The method of claim 42 in which said still image files are in BMP format.
- 45. The method of claim 4 in which the still image files are in TIFF format.
- 46. The medical video instrument according to Claim 19 wherein said medical video instrument generates video data that is displayed on said touch screen.
- 47. (cancelled)
- 48. The medical video instrument according to Claim 19 wherein said medical video instrument further comprises a storage for storing the image stream.
- 49. The medical video instrument according to Claim 19 wherein when said touch screen is in the first position, said touch screen is positioned within an interior cavity of said housing and when said touch screen is moved to the second position, the touch screen positioned at least partially outside of said cavity.

(ix) Evidence Appendix to Appeal Brief Under 37 CFR §41.37

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No evidence of any kind, including evidence submitted under 37 CFR 1.130, 1.131 or 1.132, has been entered by the Examiner and relied upon by Appellant in the appeal.

(x) Related Proceedings Appendix to Appeal Brief Under 37 CFR §41.37

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There are no related appeals, interferences or judicial proceedings known to Appellant, the Appellant's legal representative, or Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.